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PTO/SB/33 (07-05)

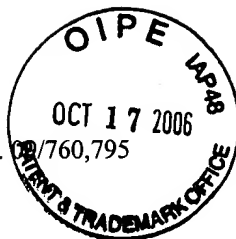
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2091-0229P	
	Application Number 09/760,795-Conf. #4941	Filed January 17, 2001	
	First Named Inventor Satoshi SETO		
	Art Unit 2157	Examiner H. A. El Chanti	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div><div><input type="checkbox"/> applicant /inventor.</div><div><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div><input checked="" type="checkbox"/> attorney or agent of record. Registration number 32,181</div><div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</div></div> <div><div> Signature #39,491</div><div><div>for Marc S. Weiner</div><div>Typed or printed name</div></div><div><div>(703) 205-8000</div><div>Telephone number</div></div><div><div>October 17, 2006</div><div>Date</div></div></div>			

☐ \*Total of 1 forms are submitted.



The Examiner has made clear errors in failing to consider all of Applicant's requests and arguments on the record and in interpreting and applying the appropriate tests and applying the prior art in rejecting claims 1-52 under 35 U.S.C. § 102(e) as being anticipated by *Fields et al.* (USP 6,412,008).

**The Examiner has Failed to Consider  
Applicant's Request for Applicant Initiated Interview**

The Examiner has made clear error by failing to consider Applicant's properly filed Request for Interview filed concurrently with a Request for Continued Examination.

As set forth in The Manual of Patent Examining Procedure (hereinafter "MPEP") in §706.07(b), a request for interview prior to first action on a continuing application should ordinarily be granted.

Applicant timely filed a Request for Applicant Initiated Examiner Interview with a Request for Continued Prosecution on March 6, 2006. Further, in Applicant's Reply filed concurrently with the Applicant Initiated Examiner Interview and a Request for Continued Prosecution on March 6, 2006, Applicant requested the Examiner contact Applicant's representative to schedule and conduct an Interview. Applicant did not receive any contact from the Examiner other than a Final Official Action mailed April 18, 2006. The Final Official Action did not acknowledge Applicant's properly filed Request for Applicant's Interview Request.

In response to the Final Official Action, Applicant filed a Reply arguing that the finality of the Official Action was improper, as the Examiner failed to consider Applicant's properly filed Request for Applicant Initiated Interview.

In response to Applicant's Reply, the Examiner issued an Advisory Action, failing, again, to acknowledge or consider Applicant's properly filed Interview Request.

As the Examiner has failed to consider Applicant's properly filed Request for Applicant Initiated Interview, the finality of the outstanding Official Action should be withdrawn and prosecution re-opened so that Applicant may have the proper opportunity to meet with the Examiner.

**The Examiner has Failed to Consider  
Applicant's Arguments Properly Asserted on the Record**

The Examiner has made clear error by failing to properly consider and properly address all of Applicant's arguments asserted on the record.

MPEP §707.07(f) clearly recites that where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In Applicant's Reply filed concurrently with a Request for Continued Examination, Applicant argued the Examiner's rejection was deficient as the cited reference failed to teach elements recited in the third, fourth and fifth steps recited in claim 1.

Not only did the Examiner not respond to Applicant's arguments regarding the third and fourth step of claim 1, but the Examiner made the first Official Action final. As the Examiner has failed to properly address all of Applicant's arguments on the record, the finality of the outstanding Official Action should be withdrawn and prosecution re-opened so that the Examiner may properly consider all of the arguments asserted by the Applicant on the record.

**The Examiner has Failed to Establish Prima Facie Anticipation  
by Failing to Provide References that Teach or Suggest All of the Claim Elements**

The Examiner has made clear error in considering certain claim elements are taught by an unduly broad interpretation of the teachings of the prior art. With regard to claim 1, the Examiner asserts that *Fields et al.* teaches all of the elements as set forth in the claim. Applicants maintain that the teachings of *Fields et al.* are insufficient to anticipate the present invention.

The disclosure of *Fields et al.* is directed to a system and method for cooperative client/server customization of web pages. *Fields et al.* discloses a process by which a client sends a request for a network file, such as a web page, to a server. The server obtains the requested network file, and a server side customization program and customizes the file. The server side customization program may also analyze the network file and may embed return customization information in a customized network file. The client receives the customized

network file, including the return customized information, from the server. A client side customization program then performs further customization on the network file (abstract).

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, as follows:

An image editing method that is performed in an image editing system equipped with a client, which has an edit-command unit for applying a command to edit image data, and an image server, connected with said client through a network, which has an editing unit for obtaining processed image data by editing said image data in response to the edit command from said edit-command unit, said image editing method comprising:

a first step of accepting an edit-start command and, in response to said edit-start command, commanding said image server to transfer editing data, having at least one editing object, which contains said image data, at said edit-command unit, and of **transferring said editing data to said client at said image server;**

a second step of **querying said image server about one editing object for obtaining said processed image data in accordance with said editing data, at said edit-command unit;**

a third step of **transferring editing information, which represents said one editing object corresponding to said inquiry, to said client, at said editing unit;**

a fourth step of **generating edit-command information which represents a command to edit said editing object, in accordance with said editing information and also transferring said edit-command information to said image server, at said edit-command unit;**

a fifth step of **obtaining intermediate processed image data by applying an editing process to said editing data in accordance with said edit-command information and also transferring said intermediate processed image data to said client, at said editing unit; and**

a sixth step of repeating said second through the fifth steps, until said edit-command information is transferred for an editing object desired and said processed image data is obtained.

Claim 1 clearly recites a plurality of exchanges between the edit-command unit at the client and the image server. For example, the first step requires the image server transferring the editing data to the client; the second step requires the edit-command unit querying the image server about one editing object; the third step requires transferring the editing data, which represent the one editing object corresponding to the inquiry to the client; and the fourth step requires transferring the edit-command information to the image server.

However, as can be seen from Fig. 2, there is only one request 50 submitted from the client to the server and one customized file 60 that is returned from the server to the client. There is no reasonable interpretation of the teachings of Fig. 2, which is more fully described in Figs. 5

and 6, and col. 4, line 30 through col. 6, line 45 that can teach or suggest the plurality of exchanges that are recited in the claims in the first through fifth steps.

In addition, claim 1 clearly recites a third step of transferring editing information, which represents said one editing object corresponding to said inquiry, to said client, at said editing unit; a fourth step of generating edit-command information which represents a command to edit said editing object, in accordance with said editing information and also transferring said edit-command information to said image server, at said edit-command unit; and a fifth step of obtaining intermediate processed image data by applying an editing process to said editing data in accordance with said edit-command information and also transferring said intermediate processed image data to said client, at said editing unit.

In support of the Examiner's rejection of these claim elements, the Examiner relies on col. 4, line 65 through col. 5, line 8 and col. 6, line 10-45. However, there is no teaching or suggestion in the citations provided by the Examiner that teach or suggest transferring editing information, which represents said one editing object corresponding to said inquiry, to said client, at said editing unit. Further, there is no teaching or suggestion in *Fields et al.* that is directed to a fourth step of generating edit-command information which represents a command to edit said editing object, in accordance with said editing information and also transferring said edit-command information to said image server, at said edit-command unit. Finally, there is no teaching or suggestion in *Fields et al.* that is directed to a fifth step of obtaining intermediate processed image data by applying an editing process to said editing data in accordance with said edit-command information and also transferring said intermediate processed image data to said client, at said editing unit.

For all of the reasons set forth above, Applicant respectfully submits that the Examiner has failed to establish prima facie anticipation by failing to teach or suggest all of the claim elements. It is respectfully submitted that claim 1 is not anticipated by *Fields et al.*

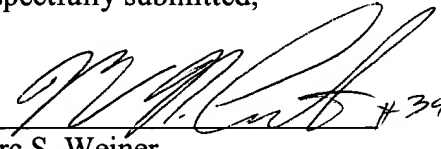
It is respectfully submitted that claims 3-4 are allowable for the reasons set forth above with regard to claim 1, at least based upon their dependency on claim 1. It is further respectfully submitted that claims 2, 5-7, 20, 46-47, 49, and 51 include at least one element similar to those discussed above with regard to claim 1 and thus, these claims together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

**Conclusion**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: October 17, 2006

Respectfully submitted,

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